

REMARKS

Claims 1, 3 to 10, 12 to 18, 20, and 22 to 30 remain pending. Claims 2, 11, 19 and 21 have been canceled. Claims 31 to 33 have been added.

Claims 1 to 30 have been rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. The Action states that the specification is not enabling for all volatile components.

The rejection of claims 1, 3 to 10, 12 to 18, 20, and 22 to 30 under 35 U.S.C. 112, first paragraph, is traversed in view of the amendments to independent claims 1 and 26. Claims 1 and 26 require that the volatile compound be of certain boiling point and vapor pressure and that it not totally dissolve in either the oil phase or the water phase. These requirements are consistent with the results set forth in working Examples I and II, which show the importance of boiling point, vapor pressure and solvation in selection of a volatile compound. The specification sets forth extensive disclosure at pp. 10 to 11 regarding the role of boiling point, vapor pressure and solvation in selection of a volatile compound. There is no language or disclosure in the specification that limits selection of volatile compounds to volatile fluorocarbon compounds. Although ethanol, a non-fluorocarbon compound, was found not to be a suitable volatile compound in working Example 1, it was unsuitable because it dissolved totally in the composition - not because it was a non-fluorocarbon compound. It is apparent from the foregoing that the specification, including the claims, set forth sufficient

disclosure to enable one skilled in the art to practice the invention without undue experimentation.

The rejection of claims 2, 11, 19, and 21 under 35 U.S.C. 112, first paragraph, is moot since those claims have been cancelled.

Claims 1 to 30 have been rejected under 35 U.S.C. 112, second paragraph, for failure to particularly point out and distinctly claim the subject matter regarded as the invention. The Action objects to the term "textured surface appearance" in claim 1. The Action maintains that it is unclear what the metes and bounds of the term are. The Action also objects to the term "textured appearance is self-foaming or self-whipping" in claim 11. The Action maintains that the terms "self-foaming" and "self-whipping" are physical properties of a composition rather than a visual aspect of the composition. The Action questioned whether the appearance of foam/lather and a composition having the textured appearance of self-foaming composition are different. The Action also objects to the term "pre-determined period of time" in claim 1. The Action maintains that the disclosure does not indicate the meaning of the term or how to ascertain or measure that time period. The Action also objects to the term "removably sealable" in claim 7. The Action admits that a cap may be sealable and removable, but that the description as recited in the claim is vague and confusing. The Action also objects to the term "original, textured surface appearance" in claim 26. The Action maintains that the meaning and metes and bounds of the term are not clear.

The rejection of claims 1, 3 to 10, 12 to 18, 20, and 22 to 30 under 35 U.S. 112, second paragraph, is not well taken. The objection to the term "textured surface appearance" is not well taken because the term is well-defined in the specification. Page 6, lines 12 to 14 states "This textured appearance is analogous to the look of foam/bubbles, and/or nooks/crannies/craters." Based on the disclosure of the specification, the term "textured surface appearance" is inclusive of all of those features. The metes and bounds of the claims have been clearly established. The objection to the term "pre-determined period of time" is not well taken because the meaning of the term is well within the ambit of ordinary usage and the ordinary meaning of the term does not require a set period of time. *Webster's II New College Dictionary*, Houghton-Mifflin Co., © 2001, defines the related term "predetermine" according to the following: to determine, decide, or establish ahead of time. Thus, the term "pre-determined period of time" has an ordinary meaning, and, by the nature of its definition, will not necessarily refer to the same length of time for each pre-determination. The disclosure of the specification is coextensive with the concept of varying lengths of time when it states at page 6, lines 21 to 24 that "...within a relatively short period of time, sometimes within as little as about 2 hours, typically from about 2 hours to about 24 hours, and certainly after weekly use." The objection "removably sealable" in claim 7 is traversed by the insertion of the language suggested in the Action. The objection to the term to the term "original, textured surface appearance" in claim 26 is traversed by the amendment to that claim deleting the term "original."

The rejection of claims 2, 11, 19, and 21 under 35 U.S. 112, second paragraph, is moot since it has been canceled.

Claims 8 and 9 are objected to under 37 C.F.R. 1.75(c) as being in improper dependent form for failure to further limit the subject matter of a previous claim. The Action maintains that claims 8 and 9 do not further limit the composition in claim 1.

The objection to claims 8 and 9 under 37 C.F.R. 1.75(c) is not well taken because they further limit the structure of the container in which the composition is situated in claim 1. The structure of the container can be a feature that impacts the physical properties of the composition. For instance, in claim 1, the texture of the surface of the composition is renewed after it is disturbed and after it is maintained for a pre-determined period of time in a sealed container.

Claims 1 to 9, 11 to 13, 23 to 25 and 30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,248,495 to Barnet et al. (the Barnet patent) in view of U.S. Patent No. 5,248,495 to Patterson et al (the Patterson patent). The Action maintains that a foam or lather would meet the 5000 cps to 100,000 cps (presumably 500,000 cps) limitation. The Action also maintains that the claim limitation requiring the composition be in a container is not limiting because the location of the composition does not affect the constituents or structure of the composition. The Actions

states that the Barnet patent teaches a self-foaming shaving composition having 0.5 - 10 wt% of a volatile self-foaming agent and 0.0005 - 0.5 wt% of a fluorosurfactant. The Action maintains that it would be obvious that the compositions of the Barnet patent encompass those having textured surfaces since the patent teaches the claimed amount of volatile self-foaming agent. The Action maintains that the Barnet patent teaches oil-in-water emulsions and skin care ingredients. The Action further maintains that it is obvious that the claimed compositions would be self-renewable and renew a textured appearance. The Action admits that the Barnet patent does not teach the claimed viscosity range. The Action states that the Patterson patent teaches a post-foaming shaving gel having viscosities between 15,000 cps and 60,000 cps and that viscosity is critical to keep the post-foaming agent in the gel. The Action maintains that it is obvious to have adjusted the viscosities of the gel of the Barnet patent to the viscosities between 15,000 cps and 60,000 cps as motivated by the Patterson patent.

The rejection of claims 1, 3 to 9, 12, 13, 23 to 25 and 30 under 35 U.S.C. 103(a) over the Barnet patent in view of the Patterson patent is traversed. The combination of the Barnet patent and the Patterson patent does not result in the claimed invention. Independent claims 1 and 30 as amended require a composition viscosity of from about 5,000 cps to about 500,000 cps and a volatile compound having a vapor pressure from about 20 mbar to about 500 mbar at 25 degrees C and a boiling point from about 45 degrees C to about 110 degrees C. Neither the Barnet patent nor the Patterson patent expressly disclose volatile

compounds having the required vapor pressure and boiling point. The Barnet patent discloses at col. 2, lines 48 to 59 volatile compounds, such n-pentane, isopentane, neopentane, n-butane and isobutane. All of these compounds have vapor pressures well above about 500 mbar and boiling points well below about 45 degrees C. The Patterson patent does not disclose volatile compounds at all. Further, the fluorosurfactants disclosed in the Barnet patent at col. 2, line 60 to col. 3, line 37 are not volatile compounds since they do not meet the claimed vapor pressure and boiling point. Still further, independent claims 1 and 26 require the composition to be an emulsion. The Barnet patent discloses emulsions, but the Patterson patent does not expressly disclose emulsions (it discloses gels). Thus, combination of the Barnet patent and the Patterson patent is not suggested.

The rejection of claims 2 and 11 under 35 U.S.C. 103(a) over the Barnet patent in view of the Patterson patent is moot since they have been canceled.

Claims 1 to 30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,667,772 to Zastrow et al. (the Zastrow patent) in view of U.S. Patent No. 6,528,070 B1 to Bratescu et al (the Bratescu patent). The Action states that the Zastrow patent teaches a cream composition having an aqueous fluorocarbon emulsion. The Action also states that the Zastrow patent teaches that the fluorocarbons have oxygen solubility, partial vapor pressure, and that mixtures thereof improve the rate of penetration of the skin. The Action also states that the Zastrow patent teaches liquids, semi-

liquids, solids and applications, such as cream, face mask, gel, etc. The Action admits that the Zastrow patent does not teach a "textured surface appearance" or "original, textured surface appearance." The Action maintains that the compositions of the Zastrow patent possess the claimed physical characteristics and that location in a jar does not affect the structural limitation of the composition itself. That Action admits that the Zastrow patent does not teach the viscosities of the claimed compositions. The Action states that the Bratescu patent teaches cosmetic compositions having viscosities as thin as 100 cps to a cream consistency of 80,000 cps. The Action maintained that it would have been obvious to adjust the viscosities of the compositions of the Zastrow patent to the viscosities as motivated by the Bratescu patent because of the expectation of successfully producing cosmetic compositions with desired viscosities.

The rejection of claims 1, 3 to 10, 12 to 18, 20, and 22 to 30 under 35 U.S.C. 103(a) over the Zastrow patent in view of the Bratescu patent is not well taken because the combination of the references is not suggested. The action states that the skilled artisan would be motivated by the Bratescu patent to adjust the viscosity of the compositions of the Zastrow patent because of an expectation of successfully producing cosmetic compositions with desired viscosities. The reference combination is not suggested because the composition of the Bratescu patent does not have a volatile compound, a critical feature of the composition of the present invention. Thus, the skilled artisan would not be motivated to adjust the viscosity of the compositions of the Zastrow patent based on the 100 cps

to 80,000 cps viscosity range disclosed in the Bratescu patent.

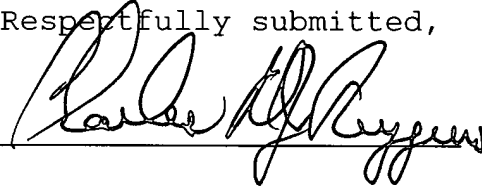
The rejection of claims 2, 11, 19 and 21 under 35 U.S.C. 103(a) over the Zastrow patent in view of the Bratescu patent is moot since they have been canceled.

New independent claims 31 to 33 clearly distinguish the references cited in the Action. The cited references do not teach the system, composition and method set forth in claims 31, 32 and 33, respectively.

Reconsideration of claims 1, 3 to 10, 12 to 18, 20, and 22 to 30 is deemed warranted in view of the foregoing, and allowance of said claims and new claims 31 to 33 is earnestly solicited.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles N. J. Ruggiero", written over a horizontal line.

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